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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/774,388	02/10/2004	Jonathan Gressel	27084	1970
27772	7590	06/05/2009		
DODDS & ASSOCIATES 1707 N STREET NW WASHINGTON, DC 20036			EXAMINER FOX, DAVID T	
			ART UNIT 1638	PAPER NUMBER
			MAIL DATE 06/05/2009	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/774,388

Applicant(s)

GRESSEL ET AL.

Examiner

David T. Fox

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 7/17/08 & 2/13/09.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 4, 5, 7 and 9-24 is/are pending in the application.
4a) Of the above claim(s) 9-16 is/are withdrawn from consideration.
5) ☒ Claim(s) 1, 4, 5, 7, 17, 18, 23 and 24 is/are allowed.
6) ☒ Claim(s) 19-22 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 10 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 09/889737.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-848)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

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Applicant's Response

Applicant's amendments of 13 February 2009 and arguments of 17 July 2008 have overcome all rejections not repeated below.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Obviousness

Claims 19-22 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Deitrich et al (US 5,731,180) in view of WO 97/29123 (JOHN INNES CENTRE), for the reasons presented on pages 18-19 of the Office action of 29 April 2008.

Applicant's arguments filed 17 July 2008 have been fully considered but they are not persuasive. Applicant urges that neither reference teaches the claimed method of using the two linked transgenes for the mitigation of introgression of beneficial traits into weedy species.

The Examiner maintains that Dietrich et al teach plant transformation with a mutant *ahas* gene conferring herbicide resistance, and claim the linkage of this gene with another gene of agronomic interest (see, e.g., claims 1 and 8); while JOHN INNES CENTRE teaches that dwarfism is an agronomic trait. Thus, the combination of the prior art teaches the same method of transforming a plant with the same transgenes as claimed, even if the purpose of said transformation is different. The fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for

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patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Conclusion

Claims 1, 4-5, 7 and 24 are deemed free of the prior art, given the failure of the prior art to teach or reasonably suggest plant transformation with a construct comprising the particularly claimed mitigating genes and agronomic genes between 0-10 centimorgans apart; wherein said very tight linkage is particularly advantageous to prevent the survival or reproduction of weedy plants accidentally transformed with the agronomic gene.

Claims 17-18 and 23 are deemed free of the prior art, given the failure of the prior art to teach or reasonably suggest plant transformation with an anti-shattering gene linked to an herbicide resistance gene, as stated on page 20 of the Office action of 29 April 2009.

Claims 1, 4-5, 7, 17-18, 23 and 24 are allowed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will

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the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David T. Fox whose telephone number is (571) 272-0795. The examiner can normally be reached on Monday through Friday from 10:30AM to 7:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anne Marie Grunberg, can be reached on 571-272-0975. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/David T Fox/

Primary Examiner, Art Unit 1638

June 3, 2009